

REMARKS

Claims 1–11 are pending in the present application.

Claims 1–9 and 11 were amended solely to eliminate European-style use of the phrase “characterized in that.”

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1–3, 5–6 and 8–11 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,118,672 to *Yamauchi et al.* This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent claim 1 recites an antenna. Such a feature is not shown or suggested in the cited embodiment of the cited reference. “Example 1” depicted in Figure 1 of *Yamauchi et al.*, cited in the Office Action as anticipating the claimed invention, does not depict an antenna, and the description of Example 1 in *Yamauchi et al.* is silent as to an antenna. The element identified by reference character 7, cited in the Office Action as satisfying the limitation of an antenna, is merely described

in *Yamauchi et al* as “the body 7 of the tuner.” *Yamauchi et al*, column 8, line 18. It should be noted that the tuner structures disclosed in *Yamauchi et al* relate to components including a connector to an external antenna, such as connector 52 depicted in Figure 18 and connector 10 depicted in Figure 2. *Yamauchi et al* does not relate to, and is silent with respect to, structures including an antenna forming part of or affixed to the device as in the claimed invention.

Independent claim 1 further recites that the shield is disposed between the antenna and the semiconductor device. Even if the tuner body 7 were considered equivalent to an antenna (which Applicant does NOT concede), the tuner body 7, shown in cut-away in Figure 1, is between the upper and lower shield portions 9 and the chip component 2, secured to the outside of the tuner body 7 within which the chip component 2 is disposed:

An upper and lower shield cover 9 are secured to the *outer surfaces* of the tuner.

Yamauchi et al, column 7, lines 20–21 (emphasis added). Accordingly, the cited embodiment within *Yamauchi et al* does not depict or describe an antenna, or specifically a shield disposed between an antenna and a semiconductor device.

Therefore, the rejection of claims 1–3, 5–6 and 8–11 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,173 to *Nagata et al*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted above, independent claim 1 recites features not depicted or described in the cited embodiment within *Yamauchi et al.* Such features are also not depicted or described within the cited portions of *Nagata et al.*

Therefore, the rejection of claims 4 and 7 under 35 U.S.C. § 103 has been overcome.



AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

Claims 1--9 and 11 were amended herein as follows:

1 1. (amended) A module comprising a substrate with a side, a semiconductor device, a shield of an
2 electrically conducting material, and an antenna, said shield being present between the antenna and
3 the semiconductor device, [characterized in that]wherein the shield and the antenna are present
4 substantially at the same side of the substrate as the semiconductor device.

1 2. (amended) A module as claimed in claim 1, [characterized in that]wherein the shield is connected
2 to the antenna by a support means.

1 3. (amended) A module as claimed in claim 2, [characterized in that]wherein the shield and the
2 antenna are metal plates which each comprise a first, a second, and a third portion, said second
3 portion adjoining the first and the third portion and being oriented substantially parallel to the
4 substrate, while at least one of said first and third portions is connected with electrical conduction
5 to electrical conductors at one of the sides of the substrate.

1 4. (amended) A module as claimed in claim 3, [characterized in that]wherein the support means
2 comprises a rubbery, electrically insulating material.

1 5. (amended) A module as claimed in claim 3, [characterized in that]wherein the support means is
2 a strip having a first end and a second end, which strip is undetachably connected at its first end to
3 the metal plate of the antenna and is fastened at its second end to the shield.

1 6. (amended) A module as claimed in claim 3, [characterized in that]wherein the third portion of
2 the antenna is provided with teeth which are connected to the electrical conductors at one of the sides
3 of the substrate.

1 7. (amended) A module as claimed in claim 2, [characterized in that]wherein the support means is
2 the carrier of the antenna and comprises an electrically insulating material, the shield is a metal plate
3 which comprises a first, a second, and a third portion, said second portion adjoining the first and the
4 third portion and being oriented substantially parallel to the substrate, while at least one of said first
5 and third portions are connected with electrical conduction to electrical conductors at one of the sides
6 of the substrate, and the support means is fastened on the shield.

1 8. (amended) A module as claimed in claim 2, [characterized in that]wherein the support means is
2 the carrier of the antenna and of the shield.

1 9. (amended) A module as claimed in claim 8, [characterized in that]wherein the support means
2 comprises a first, a second, and a third portion, said second portion adjoining the first and the third
3 portion and being oriented so as to be substantially parallel to the substrate, while said first and third
4 portions extend up to the substrate.

1 11. (amended) An electronic device as claimed in claim 10, [characterized in that]wherein a carrier
2 is present on which the module and at least one component are fastened, which component emits
3 radiation during operation of the device, the module and the component each having a height with
4 respect to the carrier such taht the height of the module is greater than the height of the component.

SUMMARY


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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